UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/775,187	USAMI, SHINYA
	Examiner	**Art Unit**	
	ADAM CHORNESKY	4127	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 February 2004*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-11* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *11 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *6/13/2005;2/11/2004*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The following is a non-final, first office action on the merits. Claims 1-11 are pending.

Specification

1.   The disclosure is objected to because of the following informalities: improper

grammar (pg. 13 line 1, pg. 17 line 27, pg. 20 line 29).

Appropriate correction is required.

Claim Objections

2.   Claims 1 and 9 are objected to because of the following informalities:

In claim 1, the statement "… a plurality pieces of partial software …" Examiner

suggests the following "… a plurality of pieces of partial software …"

Claim 9 does not end with a period.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

4.   Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

Claim 1 recites the limitation "the accessed advertisement" in line 10. There is

insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the accessed advertisement" in line 12. There is

insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the accessed advertisement information" in line 10.

There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the accessed advertisement information" in line 12.

There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the selected identification information" in line 13.

There is insufficient antecedent basis for this limitation in the claim.

Claim 9 appears to be incomplete and is thus indefinite.

Claim 10 recites the limitation "the plurality of pieces" in line 2. There is

insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the predetermined software" in lines 3, 5 and 6.

There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the advertisement information" in lines 5-6. There

is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the selected identification information" in lines 6-7.

There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the identification information" in line 8. There is

insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the identification information" in lines 10-11.

There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the predetermined software" in line 11. There is

insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the identification information" in lines 13-14.

There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the predetermined software" in 16-17. There is

insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "said combination of identification information" in

lines 19-20. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

6.   **Claims 8, 10, and 11** are rejected under 35 U.S.C. 101 because the described

system contains data structures not claimed as embodied in computer-readable media

and therefore are descriptive material per se and are not statutory because they are not

capable of causing function change in a computer. See In re Warmerdam, 33 F.3d at

1361, 31 USPQ2d at 1760.

Claim Rejections - 35 USC § 102

7.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public
> use or on sale in this country, more than one year prior to the date of application for patent in the United
> States.

8.   **Claims 1-4, 6-11 are rejected under 35 U.S.C. 102(b) as being anticipated by**

Kutaragi et al. (US 20020004743 A1).

As per claim 1, Kutaragi et al. discloses a wireless terminal advertisement system (abstract lines 1-2 via advertisement information appropriated beforehand is inserted into contents such as a game downloaded by a user) and (pg. 2 par. 27 lines 3-4 via a network, such as cable television, a broad-band wireless network, or an optical fiber network) which comprises:

an advertisement delivery server (pg. 1 par. 1 line 2 via an in-content advertising server) comprising

means for storing advertisement information and a plurality pieces of partial software of predetermined software (pg. 1 par. 10 lines 4-5 via a first server storing a plurality of digital contents to be provided),

means for, when the advertisement information is accessed, selecting at least one of the plurality of pieces of partial software corresponding to the accessed advertisement information (pg. 1 par. 10 lines 9-11 via in response to download requests for specific digital contents from the users, the digital contents distribution system distributes the specific digital contents to the user), and

means for delivering the accessed advertisement information and the selected at least one of the plurality of pieces of partial software (pg. 1 par. 10 lines 12-14 via wherein the advertisement information providing system transmits advertisement information corresponding to the specific digital contents from the database, to the user); and

a wireless terminal connected to the advertisement delivery server via a communication network (pg. 1 par. 11 lines 1-8 via the digital contents distribution

system may configure a network comprising the database, and the plurality of user

terminal devices, using one, or two or more, of the following means: cable television,

broad-band wireless network, and optical fiber network), comprising

a software storage section configured to, each time the wireless terminal

receives the advertisement information from the advertisement delivery server and the

selected at least one of the plurality of pieces of partial software, sequentially store the

received at least one of the plurality of pieces of partial software (pg. 4 par. 46 lines 10-

13 via game data G1 through Gn containing advertisement programs API through APn

are each stored in the main data storage),

a software linking means for linking the plurality of pieces of partial software

stored in said software storage section to form executable software (claim 11 lines 3-5

via said advertisement information being set into said digital contents by said

advertisement programs), and

a software executing means for executing the executable software formed by

said software linking means (claim 12 lines 7-12 via in response to download requests

for specific digital contents from said users, said digital contents distribution system

receives advertisement information corresponding to said specific digital contents from

said database, and distributes said advertisement information along with said requested

digital content).

As per claim 2, Kutaragi et al. discloses a wireless terminal advertisement

system (abstract lines 1-2 via advertisement information appropriated beforehand is

inserted into contents such as a game downloaded by a user) which comprises:

an advertisement delivery server (pg. 1 par. 7 lines 1 via the in-contents

advertising server) comprising

means for storing advertisement information and identification information for

identifying a plurality of pieces of partial software of predetermined software (claim 5

lines 7-8 via an advertisement information providing system comprising a database

storing advertisement information),

means for, when the advertisement information is accessed, selecting at least

one of the identification information for specifying the plurality of pieces of partial

software corresponding to the accessed advertisement information (pg. 4 par. 47 lines

1-5 via the sets of game data G1 through Gn each made up of a header 30 of contents

providing company name, title, date of sale, etc., and movie data 31, program data 32,

object data 33, multiple sets of texture data 34, advertising program data AP, etc.),

and means for delivering the accessed advertisement information and the

selected identification information (pg. 1 par. 12 lines 5-10 via a contents providing

system, a digital contents providing system, and the advertisement information

providing system);

a software delivery server (pg. 2 par. 16 lines 7-12 via a response to download

requests for digital contents from the users, the digital contents distribution system

distributes the advertisement information along with the requested digital content)

comprising

means for linking all or part of the plurality of pieces of partial software to form

the predetermined software made to be executable by itself (pg. 1 par. 7 lines 1-5 via

the in-contents advertising server inserts advertisement information in contents, based

on specifications of the advertiser, and information contained within contents indicating

that advertisements may be inserted),

means for storing the predetermined software (pg. 1 par. 10 lines 4-5 via a first

server storing a plurality of digital contents to be provided), and

means for delivering the predetermined software stored in the means for storing

(pg. 1 par. 10 lines 10-11 via the digital contents distribution system distributes the

specific digital contents to the user); and

a wireless terminal connected to the advertisement delivery server and the

software delivery server via a communication network (pg. 1 par. 11 lines 2-8 via a

network of the digital contents distribution system comprising the first server, the

advertisement information providing system comprising the database, and the plurality

of user terminal devices, using one, or two or more, of the following means: cable

television, broad-band wireless network, and optical fiber network), comprising

a software identification information storage section configured to, each time the

wireless terminal receives the advertisement information and the selected identification

information from the advertisement delivery server, sequentially store the identification

information (pg. 4 par 49 lines 12-20 via terminals receive advertising data under control

of the advertising program, records this in the main data storage 14 and generates a

table of information indicating addresses in the main data storage for advertisement

data, and the position the position of the advertisement target, i.e. information indicating

which advertisement insertable information shown in Fig. 6),

a combination of identification information specifying means for specifying a

combination of the identification information necessary for acquiring the predetermined

software made to be executable by linking the plurality of pieces of partial software

corresponding, respectively, to the identification information stored in said software

identification information storage section (pg. 1 par. 8 lines 3-7 via obtaining

advertisement information appropriated beforehand to the contents, at the time of

activation of the contents, and inserting the advertisement information in the contents

based on information contained within contents indicating that advertisements may be

inserted),

a software downloading means for downloading the predetermined software of

the plurality of pieces of partial software corresponding to the combination of the

identification information specified by said combination of identification information

specifying means, and a software means executing for executing the predetermined

software downloaded by said software downloading means (pg. 1 par. 10 lines 9-14 via

in response to download requests for specific digital contents from the users, the digital

contents distribution system distributes the specific digital contents to the user; and

wherein the advertisement information providing system transmits advertisement

information corresponding to the specific digital contents from the database to the user).

As per claim 3, Kutaragi et al. discloses that said wireless terminal further

comprises a partial software transmission/reception section for transmitting and

receiving particular pieces of partial software stored in said software storage section to

and from another wireless terminal via the communication network (pg. 2 par. 27 lines

1-14 via an overall system including a contents server, an advertising agency server having a database, terminals of a content providing company, advertiser terminals, user terminals, and a bank server wherein a related server or terminal is connected to a network, such as cable television, a broad-band wireless network, or an optical fiber network).

As per claim 4, Kutaragi et al. discloses that said wireless terminal further comprises an identification information transmission/reception section for transmitting and receiving particular pieces of identification information stored in the software identification information storage section to and from another wireless terminal via the communication network (as in Fig. 5, a user terminal with a network interface I/F 17 where the terminal may be wirelessly connected to the network as in pg. 1 par. 11 line 7).

As per claim 6, Kutaragi et al. discloses that said advertisement delivery server and said software delivery server are formed as a single delivery server (as in Fig. 2 where the provider 2 obtains content from the content providing company 7-1 through 7-N and advertisement information from the advertising agency server 5 and that the software and advertising are downloaded by users to user terminals).

As per claim 7, Kutaragi et al. discloses an advertisement delivery server (pg. 2 par. 27 line 7 via an advertising agency server having a database) comprising:

means for storing advertisement information and a plurality pieces of partial software of predetermined software (pg. 1 par. 10 lines 1-7 via a digital contents distribution system comprising a digital contents distribution system comprising a first

server storing a plurality of digital contents to be provided; an advertisement information

providing system comprising a database storing advertisement information);

means for, when the advertisement information is accessed, selecting at least

one of the plurality of pieces of partial software corresponding to the accessed

advertisement information (pg. 1 par.10 lines 9-11 via in response to download requests

for specific digital contents from the users, the digital contents distribution system

distributes the specific digital contents to the user); and

means for delivering the accessed advertisement information and the selected at

least one of the plurality of pieces of partial software (in combination with prior

reference, pg. 1 par. 10 lines 12-14 via the advertisement information providing system

transmits advertisement information corresponding to the specific digital contents from

the database, to the user).

As per claim 8, Kutaragi et al. discloses a wireless terminal connected to an

advertisement delivery server via a communication network (pg. 2 par. 27 lines 1-4 via a

contents provider system wherein a related server or terminal is connected to a

network, such as cable television, a broad-band wireless network, or an optical fiber

network), comprising:

a software storage section configured to, each time the wireless terminal

receives the advertisement information from the advertisement delivery server and the

selected at least one of the plurality of pieces of partial software, sequentially store the

received at least one of the plurality of pieces of partial software (pg. 4 par 49 lines 12-

20 via terminals receive advertising data under control of the advertising program,

records this in the main data storage 14 and generates a table of information indicating

addresses in the main data storage for advertisement data, and the position the position

of the advertisement target, i.e. information indicating which advertisement insertable

information shown in Fig. 6);

a software linking means for linking the plurality of pieces of partial software

stored in said software storage section to form executable software (pg. 4 par. 47 lines

1-5 via the sets of game data G1 through Gn each made up of a header 30 of contents

providing company name, title, date of sale, etc., and movie data 31, program data 32,

object data 33, multiple sets of texture data 34, advertising program data AP, etc.); and

a software executing means for executing the executable software formed by

said software linking means (pg. 4 par. 50 lines 1-6 and Fig. 7 via once the game starts

in step S8 judgment is made whether or not the position is the position for inserting

advertisement information, and in the event that this yields "YES", in step S9 the

corresponding advertisement data is position at the corresponding position in the

memory).

As per claim 9, Kutaragi et al. discloses an advertisement delivery server (pg. 1

par. 7 line 1 via the in-contents advertising server) comprising:

means for storing advertisement information and identification information for

identifying a plurality of pieces of partial software of predetermined software (pg. 2 par.

16 lines 1-12 via a plurality of servers storing digital content, an advertisement

information providing system, wherein the system distributes advertisement information

along with requested digital content in response to download requests from users);

means for, when the advertisement information is accessed, selecting at least

one of the identification information for specifying the plurality of pieces of partial

software corresponding to the accessed advertisement information (pg. 4 par 49 lines

12-20 via terminals receive advertising data under control of the advertising program,

records this in the main data storage 14 and generates a table of information indicating

addresses in the main data storage for advertisement data, and the position the position

of the advertisement target, i.e. information indicating which advertisement insertable

information shown in Fig. 6 this is); and

means for delivering the accessed advertisement information and the selected

identification information (pg. 2 par. 16 lines 1-12 via a plurality of servers storing digital

content, an advertisement information providing system, wherein the system distributes

advertisement information along with requested digital content in response to download

requests from users).

As per claim 10, Kutaragi et al. discloses a software delivery server (pg. 1 par. 9

lines 3-14 via a digital contents distribution system comprising a first server storing a

plurality of digital contents to be provided, wherein, in response to download requests

for specific digital contents from the users, the digital content is provided to the

requesting user) comprising:

means for linking all or part of the plurality of pieces of partial software to form

the predetermined software made to be executable by itself (pg. 2 par. 16 lines 4-12 via

an advertisement information providing system having a database storing advertisement

information to be set into advertising areas within the digital contents, wherein, in

response to a user download request, the advertisement information is distributed along with the requested digital content);

means for storing the predetermined software (pg. 1 par. 9 lines 3-7 via a first server storing a plurality of digital contents to be provided, and an advertisement information providing system comprising a database storing advertisement information); and

means for delivering the predetermined software stored in the means for storing (pg. 1 par. 9 lines 8-13 via in response to download requests for specific digital contents from the users, the digital contents distribution system receives advertisement information and distributes specific digital contents to the user).

As per claim 11, Kutaragi et al. discloses a wireless terminal connected to an advertisement delivery server and a software delivery server via a communication network (pg. 1 par. 11 lines 1-8 and Fig. 1 via a network comprising a first server and a plurality of user terminal devices: cable television, broad-band wireless network, and optical fiber network where the software delivery server is the advertising agency server 5 and the contents provider 2, and the terminals are the users 9-1 through 9-N), comprising:

a software identification information storage section configured to, each time the wireless terminal receives the advertisement information and the selected identification information from the advertisement delivery server, sequentially store the identification information (Fig. 5 shows user terminal 12 with main data storage 14 containing game data G1 each having an associated advertisement program AP1-1Pn);

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

10.   Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Kutaragi et al. (US 20020004743 A1) in view of Dujari (US 6199107 B1).

As per claim 5, Kutaragi et al. discloses the claimed invention of claim 1, but is

silent regarding that said wireless terminal further comprises a relationship displaying

means for displaying the relationship between the group of pieces of partial software of

executable software and pieces of partial software currently stored in the storage

section.

Dujari teaches in abstract lines 1-3 a method and system for caching partial

downloads of network content and using that cached partial content to satisfy requests

for content from client applications.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the in-contents advertising method, server and program

transferring medium of Kutaragi et al. to include the partial file caching and read range

system and method of Dujari in order to avoid having to repeat download of content that

has already been downloaded (col. 1 lines 21-31).

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure. include:

Finer et al. (EP001180385A2), which teaches a computer aided board game

system played by means of a wireless remote terminal.

Pavlovic et al. (US 20020059563 A1), which teaches a computer-implemented

method and system for allowing software to carry its own specification.

Kost et al. (US 20020154691 A1), which teaches a system and a process for

converting analog or digital video presentations such that the presentations remain

within a browser as used in Intranet or Internet related applications or the like.

Wells (US 20030064805 A1), which teaches a disclosed gaming machine,

provides methods and apparatus for operating a wireless game player that presents a

game of chance executed on a gaming machine in communication with the wireless

game player.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to ADAM CHORNESKY whose telephone number is

(571)270-5103. The examiner can normally be reached on Monday - Thursday 7:30

AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Lynda Jasmin can be reached on 571-270-3033. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A. Chornesky

/Lynda Jasmin/
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